

REMARKS

The present response is intended to be fully responsive to all points of rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application is respectfully requested.

1. Telephone Interview

Applicant conducted a telephone interview of this application with Examiners Urban and Le on January 29, 2004. Applicant was represented by Neilesh Patel and Lawrence Aaronson. During the telephone interview, Applicant made various remarks in support of the patentability of the claimed invention. The remarks made by the Applicant are set forth below in this response to the final Office Action. The Examiners indicated that Applicant's remarks assisted them in understanding the claimed invention and that they would reconsider the rejection of the pending claims.

2. Claims

Claims 1-24, 26-27 are pending in the application. Applicant has not cancelled or amended any claims in this response. Therefore, the pending claims are the same as those pending as of the response dated October 16, 2003.

3. Response to Claim Rejections

In the final Office Action, the Examiner rejected the pending claims for the same reasons set forth in the Office Action dated August 16, 2003. The Examiner rejected claims 1-4, 6-7, 15-16, and 24 under 35 U.S.C. § 102(e) as being anticipated by Kennedy et al. (U.S. Patent No. 6,377,825). Additionally, the Examiner rejected claims 8, 10, 13, 17, 19, 22, and 25 under 35 U.S.C. § 103(a) as being unpatentable over Kennedy in view of Kravitz (U.S. Patent No. 6,035,217). Still additionally, the Examiner rejected claims 5, 9, 18, 11-12, and 20-21 as being

unpatentable over a combination of Kennedy and Kunihiro (U.S. Patent No. 5,915,288), Kennedy, Kravitz, and Kirbas (U.S. Patent No. 6,449,497), or Kennedy, Kravitz, and Maloney (U.S. Patent No. 6,453,169).

Of rejected claims 1-13, 15-22, 24, 26-27, claims 2-13, 15, 17-22, 24, and 26-27 depend on independent claims 1 or 16. Independent claims 1 and 16 distinctly claim processing performed by a control system coupled externally to a subscriber terminal.

The control system is arranged to have a controller and an actuator. When the actuator is actuated, the controller determines an action to be taken by the subscriber terminal. The action to be taken depends on a status of the subscriber terminal. If the status is a first status, then the controller determines a first action to be taken by the subscriber terminal and sends a first directive to the subscriber terminal indicating the first action to be taken. Alternatively, if the status is a second status, then the controller determines a second action to be taken by the subscriber terminal and sends a second directive to the subscriber terminal indicating the second action to be taken. As recited by the claims, the first status is different than the second status, the first action is different than the second action, and the first directive is different than the second directive.

In order for a reference to anticipate a claimed invention, the reference must teach each and every element of the claimed invention. (M.P.E.P. § 2131). Applicant submits that the rejection of independent claims 1 and 16 is improper because Kennedy fails to teach each and every element of independent claims 1 and 16.

Kennedy is directed to an interface module that receives a spoken command, determines that the status of the telephone is "on-hook" (in which case the interface module enters a voice recognition mode), and signals the telephone to dial a telephone number representative of the

spoken command. Applicant submits, however, that Kennedy does not disclose determining a first status or second status of the subscriber terminal, and sending a corresponding first or second directive to the subscriber terminal, as recited by independent claims 1 and 16. Kennedy discloses that the interface module determines a single status of the telephone, i.e., that the telephone is "on-hook", and sends to the telephone a single directive, i.e., to dial a telephone number. But if the status of the telephone is different, Kennedy does not disclose that the interface module would send another, different, directive to the subscriber terminal. Therefore, Kennedy does not disclose determining a first or second status of the subscriber terminal and sending a corresponding first or second directive to the subscriber terminal, as claimed by independent claims 1 and 16.

In the Advisory Action, the Examiner stated that "[t]he Kennedy reference teaches or suggests control system coupled externally to a subscriber terminal and has same directive for different status of the terminal." This is Applicant's point as well: Kennedy provides the same directive regardless of the status of the subscriber terminal. This is not what Applicant's claims recite. Kennedy fails to disclose or suggest the invention as recited by independent claims 1 and 16. Therefore, Kennedy does not anticipate claims 1 and 16. Because claims 2-4, 6-7, 15 and 24 each depend from claim 1 or claim 16, it follows that Kennedy also fails to anticipate claims 2-4, 6-7, 15 and 24.

Further, Applicant submits that the secondary Kravitz, Maloney and Kirbas references fail to make up for the deficiency of Kennedy, and that any combination of Kennedy, Kravitz, Maloney and Kirbas thus also fails to disclose or suggest the invention of claims 1 or 16. Since claims 8, 10, 13, 17, 19, 22 and 25 each depend from claim 1 or claim 16, Applicant therefore

submits that any combination of Kennedy, Kravitz, Maloney and Kirbas fails to render the invention of claims 8, 10, 13, 17, 19, 22 and 25 obvious.

Consequently, Applicant submits that all of the pending claims are in condition for allowance, and Applicant requests favorable reconsideration.

4. Comments on Examiner's Response to Arguments

In the final Office Action, the Examiner identified another reference, Griffith (U.S. Patent No. 6,128,514). However, the Examiner did not set forth a statutory rejection (e.g., a § 102 or § 103 rejection) of the claimed invention over Griffith.

In any event, Applicant submits that Griffith does not disclose or suggest the presently claimed invention. In particular, Griffith does not disclose an external control system that determines a first or second status of the subscriber terminal and sends a corresponding first or second directive to the subscriber terminal.

In the presently claimed invention, the control system is coupled externally to the subscriber terminal. By coupling the control system externally to the subscriber terminal, the control system can provide simplified control for substantially any subscriber terminal. A user couples his or her subscriber terminal to the control system and actuates the actuator on the control system to cause the control system to send directives to the subscriber terminal. The directives may cause the subscriber terminal answer a call or hang up a call, depending on the status of the subscriber terminal. Therefore, the control system may allow a user to operate his or her subscriber terminal with simplified control without having to modify the subscriber terminal in any way.

In stark contrast, Griffith discloses a turbo dial button integrated into a telephone. The turbo button is a single button on the telephone. Pressing the turbo dial button causes a

microprocessor on the telephone to perform different functions depending on the status of the telephone. For instance, pressing the turbo button may cause the telephone to answer a call or hang up a call depending on the status of the telephone.

Although Griffith discloses a turbo button, Griffith does not disclose an external control system that determines a status of the subscriber terminal and sends a directive to the subscriber terminal, as claimed. There is no need for Griffith to have such a control system because the telephone itself determines which functions to perform when the turbo button is pressed. No directives have to be sent to the telephone. Thus, modifying Griffith to include the presently claimed external control system would be redundant and illogical.

On the other hand, the presently claimed invention allows an existing subscriber terminal to be coupled to the control system so that, when the actuator is pressed, the control system can send to the subscriber terminal a first or second directive corresponding to a first or second status of the subscriber terminal.

In the Advisory Action, the Examiner stated that "[t]he Griffith reference teaches or suggests determining different status of a subscriber terminal (cellular telephone) and different directives (actions) are sent and activated for a particular status by a control system (microprocessor)," citing column 5, lines 24-37 of Griffith. However, a reading of that section of Griffith makes clear that what Griffith is referring to is the turbo dial button on the cell phone, not any sort of external control system as presently claimed.

In summary, there is no disclosure or suggestion in any of the cited art, including Kennedy, Kravitz, Maloney, Kirbas, and Griffith, to have an external control system that operates in the manner presently claimed. Any modification of those references to achieve the presently claimed invention would be based on hindsight reconstruction at best, and further

would change the basic operation of the prior art or result in a redundant, illogical arrangement.

The Examiner has cited no evidence to the contrary. Consequently, Applicant submits that the invention as recited in claims 1-13, 15-22, 24, 26-27 patentably distinguish over the art of record.

5. Conclusion

In view of the foregoing, Applicant requests favorable reconsideration and allowance of all of the pending claims. Should the Examiner have any questions, the Examiner is encouraged to telephone the undersigned at (312) 913-0001.

Respectfully submitted,

**McDONNELL BOEHNEN
HULBERT & BERGHOFF**

Date: June 2, 2004

By:



Lawrence H. Aaronson
Reg. No. 35,818